

09/993,192

**REMARKS**

Claim 17 is pending. Upon review of the specification the Applicants herein respectfully request the Examiner to amend the specification to correct a clerical error.<sup>1</sup>

**Rejections under 35 USC §112, paragraphs 1 and 2**

The Applicants now present amended claim 17 to require an isolated nucleic acid comprising SEQ ID NO:3. Since the Applicants unambiguously describe the structure of SEQ ID NO:3 in the written description, and the claim merely requires an isolated nucleic acid comprising SEQ ID NO:3, the Applicants respectfully submit to the Examiner that the issues of possession and description are now obviated in view of the state of the art at the time of the invention.

Accordingly, the Applicants respectfully request the Examiner to withdraw both rejections.

**Rejection under 35 USC §102(b)**

Rhee, *et al.*, however, cited by the Examiner is the instant Applicants' very own published application from which priority is properly claimed as acknowledged by the U.S. Patent and Trademark Office in the Official Filing Receipt included herewith. Accordingly, as discussed *supra* this issue is moot. However, even if the Applicants did not have priority to U.S. Ser. No. 09/674,617, filed January 3, 2001, the September 8, 2000 publication of that application, i.e., WO 00/52133, is not available as a prior art reference under 35 USC §102(b) because it published *less than a year* before the filing date of the instant application.

The Applicants therefore respectfully request the Examiner to withdraw the rejection.

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<sup>1</sup> SEQ ID NO:3 is the base sequence of the KEX1 gene. Specification page 10, lines 10-13.

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### CLAIM TO PRIORITY

The Applicants' priority claim to U.S. Ser. No. 09/674,617, filed January 3, 2001 is properly confirmed by the U.S. Patent and Trademark Office in *two* separate Official Filing Receipts included herewith.

#### Claim to Priority

The Applicants respectfully point out that no special language is required in making the *claim* for priority, *per se*, and any expression which can be reasonably interpreted as claiming the benefit of the application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration the application transmittal letter.<sup>2</sup> The Applicants also respectfully point out to the Examiner that the term "application" as used in 37 CFR §178 discussed *infra* necessarily refers to all documentation filed at the time of the application for patent to receive a filing date as well as properly entered additions and amendments thereto. *See*, 35 USC §111.

#### 37 CFR 1.78 under (a)(2)(i) specifically requires:

[A]ny nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application (emphasis added).

#### 37 CFR 1.78 (a)(2)(ii) further requires:

This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application ... These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application (emphasis added).

<sup>2</sup> *See*, e.g., MPEP §201.14(b) ¶3.

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37 CFR 1.78 (a)(2)(iii) then requires, in addition to (i) and (ii):

If the later-filed application is a nonprovisional application, the reference required by this paragraph must be *included* in an application data sheet (§ 1.76), or the *specification* must contain or be amended to contain such reference in the first sentence following the title (emphasis added). However, the Applicants respectfully point out, *no time frame is expressly provided for this additional requirement.*

#### THE FACTS OF THE APPLICATION

**The 1.78(a)(2)(i) "reference" was present in the application as filed.**

As required under 37 CFR 1.78(a)(2)(i), the originally filed application for patent contained a reference to each prior-filed copending nonprovisional application and international application from which priority was claimed.<sup>3</sup> Accordingly, the claim to priority *per se* was present in the original application for patent. In other words, the "reference" under 1.78(a)(2)(i) was present in the original application.

**The term "reference" under 1.78(a)(2)(ii) refers to the same "reference" required under 1.78(a)(2)(i).**

1.78(a)(2)(ii) specifically begins by referring to "this reference ...". Therefore, the term "reference" as used in 1.78(a)(2)(ii) necessarily refers to the same "reference" in 1.78(a)(2)(i). Please recall, however, that as recited in 1.78(a)(2)(i) the application for patent, i.e., the documentation, must *contain* the "reference" *or be amended to contain* the "reference".

1.78(a)(2)(ii) then requires "this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application." Accordingly, 1.78(a)(2)(ii) necessarily refers to the ability to *amend* the application within the specified time frame to contain the "reference" required under 1.78(a)(2)(i). Since the originally filed papers provided the "reference" no amendment was necessary to satisfy this requirement, *per se*.

<sup>3</sup> Copies of the original filing papers and filing receipt, for example, are attached hereto.

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37 CFR 1.78 (a)(2)(iii) additionally requires the specification to contain or be amended to contain a cross-reference in the first sentence following the title. However, no time frame is expressly required for this amendment.

The Applicants respectfully submit that the claim to priority as required under 37 CFR 1.78 (a)(2)(i) and (ii) was present upon filing the application. Requiring the Applicants to Petition the Commissioner for Acceptance of an Unintentionally Delayed Claim for Priority in this case is analogous to a physician compelling chemotherapy for a condition that does not exist. 37 CFR 1.78 (a)(3) particularly states that if the "reference" [under 1.78(a)(2)(i)] is presented after the 1.78(a)(2)(ii) time period a Petition To Accept An Unintentionally Delayed Claim For Priority must be filed. The rule expressly states that the Petition must be accompanied by a statement that the entire delay between the date the *claim* was due under paragraph (a)(2)(ii) and the date the *claim* was filed was unintentional.

The Applicants have indeed attempted to amend the specification in view of the application as filed to satisfy this requirement, i.e., in the Amendment filed November 4, 2003. The Applicants, again, respectfully request the Examiner to enter the amendment as presented on November 4, 2003, i.e., please insert the following paragraph just beneath the title of the invention at page 1 of the specification:

--This application is a divisional of application U.S. Ser. No. 09/674,617, filed January 3, 2001, now abandoned, from which priority is indicated herein under 35 USC §371 PCT/KR00/00173, filed March 4, 2000 (International Publication No. WO 00/52113, published in English on September 8, 2000) and Republic of Korea application 10743, filed March 3, 2000, and Republic of Korea application 7177, filed March 4, 1999.--

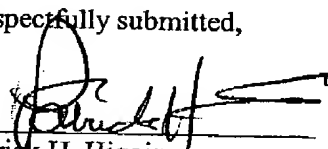
\* \* \*

For all the foregoing reasons, the Applicants submit that claim 17 is in condition for allowance. Early action toward this end is courteously solicited.

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The Commissioner is authorized to charge any deficiency or credit any overpayment in connection herewith to Deposit Account No.13-2165.

Respectfully submitted,



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Date: March 29, 2004

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## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/993,192	11/14/2001	1635	740	4220-116.1 US	13	4	2

CONFIRMATION NO. 8974

## UPDATED FILING RECEIPT



\*OC000000007689635\*

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Date Mailed: 03/21/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

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## Domestic Priority data as claimed by applicant

THIS APPLICATION IS A DIV OF 09/674,617 01/03/2001  
WHICH IS A 371 OF PCT/KR00/00173 03/04/2000

## Foreign Applications

REPUBLIC OF KOREA 1999/7177 03/04/1999  
REPUBLIC OF KOREA 2000/10743 03/03/2000

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09/993,192	11/14/2001	1635	740	4220-116.1 US	13	4	2

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Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

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REPUBLIC OF KOREA 2000/10743 03/03/2000

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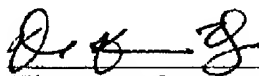
## Type of Documents:

1. Acknowledgment Post Card;
2. "Express Mail" Certificate;
3. Utility Patent Application Transmittal;
4. Specification (37 pgs) Claims (5 pgs) & Abstract (1 pg);
5. 13 sheets of Formal drawings;
6. Copy of Declaration & Power of Attorney (signed);
7. Copy of Recorded Assignment;
8. Preliminary Amendment; and
9. Check in the amount of \$740.00.

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Diane Dunn McKay

(Typed or printed name of person mailing paper or fee)



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**UTILITY PATENT APPLICATION TRANSMITTAL****(Large Entity)***(Only for new nonprovisional applications under 37 CFR 1.53(b))*Total Pages in this Submission  
73**TO THE ASSISTANT COMMISSIONER FOR PATENTS**Box Patent Application  
Washington, D.C. 20231

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

**Hansenula Polymorpha Mutants and Process for the Preparation of Recombinant Proteins Using the Same**

and invented by:

**Rhee, S. et al.**If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 09/674,617

Which is a:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: \_\_\_\_\_

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Enclosed are:

**Application Elements**

1. ☒ Filing fee as calculated and transmitted as described below
2. ☒ Specification having 42 pages and including the following:
  - a. ☒ Descriptive Title of the Invention
  - b. ☐ Cross References to Related Applications (if applicable)
  - c. ☐ Statement Regarding Federally-sponsored Research/Development (if applicable)
  - d. ☐ Reference to Microfiche Appendix (if applicable)
  - e. ☒ Background of the Invention
  - f. ☐ Brief Summary of the Invention
  - g. ☒ Brief Description of the Drawings (if drawings filed)
  - h. ☒ Detailed Description
  - i. ☒ Claim(s) as Classified Below
  - j. ☒ Abstract of the Disclosure